

CUSTOMER NO.: 24498
Serial No.: 10/590,330
Final Office Action dated: 07/24/08
Response dated: 10/02/08

PATENT
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REMARKS

The Final Office Action mailed July 24, 2008 has been reviewed and carefully considered. Reconsideration of the above-identified application, as herein amended and in view of the following remarks, is respectfully requested.

Claims 1, 3-16 and 18-20 are pending in this application. Claims 1, 3, 9 and 15 have been amended. Claims 2 and 17 have been cancelled without prejudice. No new matter has been added.

§102 and 103 REJECTIONS

Claims 1, 6 and 8 were rejected under 35 U.S.C. §102(e) as being unpatentable over U.S. Patent No. 6,592,627 to Agrawal et al. (hereinafter "Agrawal"). Claims 2-8 and 15-20 were rejected under 35 U.S.C. 103(a) as being unpatentable over Agrawal in view of U.S. Patent No. 6,341,306 to Rosenschein et al. (hereinafter Rosenschein). Claim 7 was rejected under 35 U.S.C. 103(a) as being unpatentable over Agrawal in view of U.S. 5999179 to Kekic et al. (hereinafter Kekic). Claims 9-14 were rejected under 35 U.S.C. 103(a) as being unpatentable over Agrawal in view of "Shared Folders: Your Online Conference Room" by Doug Anderson, hereinafter "Anderson." Applicant respectfully disagrees with the rejections.

Claim 1 has been amended to incorporate the features of claim 2, namely to recite, *inter alia*:

"wherein said association step further comprises enabling an options list to appear with respect to the at least one first e-mail message;

'selecting an associate option on the options list; and

'selecting the second e-mail, wherein the second e-mail is caused to be automatically associated to the at least one first e-mail to form an associated group of e-mails;...'"

Claim 9 has been amended to recite, *inter alia*, "controlling whether at least one of the user-defined discussion topic heading and at least one associated email is to be displayed to a recipient of the at least one email message by selecting at least one of a show associations option and a hide associations option on a reply e-mail to be sent to a recipient; and showing

CUSTOMER NO.: 24498
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PATENT
PU030287

at least one of the discussion topic heading and associated e-mails of the reply e-mail to the recipient if the show associations option is selected."

Claim 15 has been amended to recite, *inter alia*, "selecting a second e-mail for causing the second e-mail to be automatically associated to the at least one first e-mail to form the associated group of e-mails.

While Agrawal generally teaches a system for sorting Emails, the sorting system of Agrawal matches an incoming email to a profile of a folder, and does not enable an email to be directly associated to another email, as presently claimed. In Agrawal, one or more documents (emails) are moved into the folders based on their respective profiles. Each profile is determined based on a sample document which represents a user-desired example of the type of document that folder should contain. An incoming email is matched to a folder based on having the highest probability of matching content to the folder.

Thus, Agrawal's system is based on learning folder profiles based on sample documents and moves remaining documents into the folders accordingly. *See Abstract*, and Col. 2, lines 50-53, which recites: "[A]lso, the method includes automatically associating substantially all of the documents in the database with one or more folders, based on the sample documents." However, there is no disclosure or suggestion in Agrawal of at least associating the at least one first email with a second email by enabling an association option which further comprises enabling an options list to appear with respect to the at least one first e-mail message; selecting an associate option on the options list; and selecting the second e-mail, wherein the second e-mail is caused to be automatically associated to the at least one first e-mail to form an associated group of e-mails, essentially as claimed in claims 1 and 15.

It is important to note that in Agrawal, since emails are organized by simply being assigned to folders, a new folder must be created for each different topic, and furthermore, in order for Agrawal's document association to occur, a sample document or rules representative of the desired classification indicia must then be put into the folder to represent its profile. *See Col. 4, lines 51-60*: "[A]s shown in block 50, the user can establish a tree-like hierarchy of empty folders by conventional means... Moving to block 52, the user inputs, for each folder, one or more classification indicia in the form of sample documents. In addition, the user can define classification rules such as "send all emails from John to folder #3."

In stark contrast to Agrawal, the present invention advantageously provides a user-controlled e-mail organization technique which eliminates the need to create a new folder

CUSTOMER NO.: 24498**Serial No.: 10/590,330****Final Office Action dated: 07/24/08****Response dated: 10/02/08****PATENT****PU030287**

for each discussion topic. In the present invention, emails which do not have the same sender or subject heading may be directly associated with each other. The fact that the need to create a new folder for each new topic is eliminated is, indeed, a key focus of the present invention. See specification, page 2, lines 4-10. However, in Agrawal, it is clear that only emails which are similar to a sample document are grouped together, and thus in any way 'associated' with each other.

Nowhere in Agrawal is it disclosed or suggested that a second email is selected to cause association of same with a first email.

Finally, Agrawal fails to disclose or suggest at least controlling whether at least one of the user-defined discussion topic heading and associated emails is to be displayed to a recipient of the at least one email message by selecting at least one of a show associations option and a hide associations option on a reply e-mail to be sent to a recipient; and showing at least one of the discussion topic heading and associated e-mails of the reply e-mail to the recipient if the show associations option is selected, essentially as claimed in claim 9.

It is reiterated that the entire system and method of Agrawal is directed towards organizing documents on a user's personal computer only. There is no mention whatsoever of any means for controlling how an email is to be displayed to a recipient, namely, whether the information on an e-mail's associations may be shown to or hidden from a recipient of the email.

The Examiner points to Col. 7, lines 53-56 with regards to the show/hide associations options and states: "...all users would have the same functionality within their inboxes and thus would all have the same option to show or hide associations." Indeed, Col. 7, lines 53-56 recites:

"Proceeding to block 104 the logic can switch between the normal inbox view and the category based view as desired by the user."

Clearly, Agrawal simply describes wherein a user may switch between viewing a normal inbox view and a folder-based view when viewing his/her emails. Such a folder-based view is presented for display to the user only, as desired by the user. This is not to be confused with a user having the ability to control the way an email is to be displayed to another user (a recipient) as essentially presently claimed in claim 9. There is no disclosure or

CUSTOMER NO.: 24498**Serial No.: 10/590,330****Final Office Action dated: 07/24/08****Response dated: 10/02/08****PATENT****PU030287**

suggestion nor any ability for a user to control whether at least one of the user-defined discussion topic heading and associated emails is to be displayed to a recipient of the at least one email message by selecting at least one of a show associations option and a hide associations option on a reply e-mail to be sent to a recipient; and showing at least one of the discussion topic heading and associated e-mails of the reply e-mail to the recipient if the show associations option is selected, essentially as claimed in claim 9.

With respect to claim 15, it is respectfully asserted that Rosenschein fails to cure the deficiencies of Agrawal. Rosenschein involves a system for obtaining and retrieving information from a database by designating at least one word appearing in a display of a body of text generated by a first computer, wherein the at least one designated word is transmitted via a network to a second computer. Data relating to the at least one designated word are received from the second computer. However, Rosenschein has nothing to do with email organization, much less organizing e-mail messages to form at least one of an associated group of e-mails or an associated e-mail-to-topic group in at least one of the user's mailboxes. Indeed, the Examiner merely cited Rosenschein as allegedly teaching right clicking on an options list. However, it is readily apparent that Rosenschein fails to cure the deficiencies of Agrawal, and namely fails to disclose or suggest at least wherein the associated group of e-mails is formed by the user causing an options list to appear with respect to at least one first e-mail message, selecting an associate feature from said options list, and selecting a second e-mail for causing the second e-mail to be automatically associated to the at least one first e-mail to form the associated group of e-mails, essentially as claimed in claim 15.

With respect to claim 9, it is respectfully submitted that Anderson fails to cure the deficiencies of Agrawal. Anderson is cited as allegedly teaching a 'global email folders based on projects.' What Anderson teaches is a 'shared folder' concept, to simulate an online conference room in which everything that is put into a folder in one user's Cabinet, appears in the same folder in other users' cabinets, and vice versa. However, Anderson fails to disclose or suggest a least controlling whether at least one of the user-defined discussion topic heading and at least one associated email is to be displayed to a recipient of the at least one email message by selecting at least one of a show associations option and a hidc associations option on a reply e-mail to be sent to a recipient; and showing at least one of the discussion topic heading and associated e-mails of the reply e-mail to the recipient if the show associations option is selected, essentially as claimed in claim 9.

CUSTOMER NO.: 24498
Serial No.: 10/590,330
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PATENT
PU030287

After careful review, the Applicant noted that Anderson generally describes 'folder rights' in which documents in the shared folder carry their own set of rights, independent of the rights granted by the folder. In Anderson, users must be granted rights to documents in a shared folder by the owner of the document. However, this is not to be confused with controlling whether at least one of the user-defined discussion topic heading and at least one associated email is to be displayed to a recipient of the at least one email message by selecting at least one of a show associations option and a hide associations option on a reply e-mail to be sent to a recipient, as presently claimed. Instead, in Anderson, each document owner must separately grant the user the right to view the document. **There is no provision in Anderson enabling a user to control whether a recipient of an email message is be presented with a user-defined discussion topic heading or associated email messages to the email message being sent.**

Accordingly, it is respectfully asserted that independent Claim 1 is patentably distinct and non-obvious over Agrawal for at least the reasons set forth above. Claims 6 and 8 depend from claim 1 and are therefore believed to be patentable and nonobvious for at least the reasons stated for claim 1.

Also, it is respectfully asserted that independent Claim 9 is patentably distinct and non-obvious over Agrawal in view of Anderson for at least the reasons set forth above. Claims 10-14 depend from claim 9 and are therefore believed to be patentable and nonobvious for at least the reasons stated for claim 9.

Further, it is respectfully asserted that independent Claim 15 is patentably distinct and non-obvious over Agrawal in view of Rosenschein for at least the reasons set forth above. Claims 16-20 depend from claim 15 and are therefore believed to be patentable and nonobvious for at least the reasons stated for claim 15.

With respect to the §103 rejection of claims 2-5 and 7, the rejection of claims 2-5 and 7, is based, in part, on the contention that Agrawal discloses or suggests the features of claim 1, from which such claims respectively depend. However, in light of the above amendments and discussion, it is clear that the combination of Agrawal and/or Rosenschein and/or Kekic is legally deficient, since, at the very least, as explained above, Agrawal does not disclose or suggest the features of claim 1, from which claims 2-5 and 7 depend.

It is therefore respectfully submitted that the present invention is not disclosed or suggested by the cited references taken alone or in combination. Claims 1, 3-16 and 18-20

CUSTOMER NO.: 24498
Serial No.: 10/590,330
Final Office Action dated: 07/24/08
Response dated: 10/02/08

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PATENT
PU030287

are believed to be in condition for allowance for at least the reasons stated above. Early and favorable reconsideration of the case is respectfully requested.

CONCLUSION

In view of the foregoing, Applicants respectfully request that the rejections of the claims set forth in the Final Office Action of July 24, 2008 be withdrawn, that pending Claims 1, 3-16 and 18-20 be allowed, and that the case proceed to early issuance of Letters Patent in due course.

It is believed that no additional fees or charges are currently due. However, in the event that any additional fees or charges are required at this time in connection with the application, they may be charged to Applicants' representatives Deposit Account No. 07-0832.

Respectfully submitted,
LOUIS ROBERT LITWIN ET AL.

By:



Jeffrey D. Hale, Attorney
Registration No. 40,012
(609) 734-6444

JDH:pdf

Thomson Licensing LLC
Patent Operations
P.O. Box 5312
Princeton, NJ 08543-5312

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